

Remarks

The present response is to the Office Action mailed in the above-referenced case on February 11, 2008. Claims 13-23 are presented for examination. There are no amendments to the claims made in the present response

Examiner's Response to Arguments

3. It is not seen wherein applicant responded to the Examiners contentions set forth in section 4 of the previous Office action mailed 10/12/2007, which in turn directs attention to section 10 of the previous Office action mailed 5/7/2007. Applicant's failure to respond to the contentions of said section 4 is considered supporting the Examiners contentions that the instant invention is indeed obvious when considering the combination of APA, case law and/or Kolling. Again as set forth in said section 4:

"If applicant is of the opinion that the APA does not set forth aggregation of all of an individual's bill paying requirements, then resort may be had to the teachings of Kolling to show that it is known in the bill pay art to provide a system that is capable of interfacing with all of a person's billing needs. See for example, the abstract, figures and col. 1, lines 14- 37, col. 2 lines 63 through col. 4 line 18, col. 11 line5 through col. 13, lines 15, etc.

At the time of the invention it would have been obvious to one of ordinary skill in the art to apply the teachings of Kolling to APA in order to aggregate all of a person's billing requirements into one location for the purpose and benefit of convenience, to both the person and the billers in standardizing the method in which bills are paid for the additional benefit of saving the billers money by minimizing failures of payment."

Accordingly, the rejection of section 10 of the previous Office action mailed 5/7/2007 is sustained and incorporated herein (as set forth below in the corresponding rejection under 35 USC 103) as further explained in section 4 of the previous Office action mailed 10/12/2007 and expounded upon immediately above.

Applicant's response

Applicant points out to the Examiner that a rejection relying upon APA was not made in the Office Action mailed 10/12/2007. The Examiner states that applicant's remarks regarding APA were not persuasive in the "Response to Arguments" portion of the Office Action, but failed to re-assert the rejection. Applicant is under no obligation to respond to rejections that are not formally made in an Office Action.

Applicant does provide, for the record, a valid response to the Examiner's misuse of APA in the present Office Action. In the Office Action dated 5/7/2007, the Examiner argues:

"Regarding claim 13, APA sets forth an interactive bill-payment system for online management, viewing and payment on behalf of a user of itemized bills by proxy over a data-packet-network (page 2, lines 17-19 "many people now do their banking, stock, trading, and so forth from the comfort of their own homes via internet access"),

Applicant's background portion of the specification on page 2, lines 17-19 recites; "For example, many people now do their banking, stock trading, shopping, and so forth from the comfort of their own homes via Internet access."

Applicant is surprised that the Examiner believes these two sentences teach applicant's claimed, "an interactive bill-payment system for online management, viewing and payment on behalf of a user of itemized bills by proxy over a data-packet-network." This passage in applicant's background portion alludes to a user may go online to pay bills. There is no mention of *itemized* bills or of *viewing* and *payment on behalf* of a user of *itemized* bills by *proxy*.

Applicant argues that in order for the Examiner to come to the conclusion that the sentence; "For example, many people now do their banking, stock trading, shopping, and so forth from the comfort of their own homes via Internet access." reads on "an interactive bill-payment system for online management, viewing and payment on behalf

of a user of itemized bills by proxy over a data-packet-network” , the Examiner must be adding subject matter to APA because the teaching or suggestion simply is not there.

Examiner's rejection

The Examiner continues to state that APA teaches; “A first sever node connected to the network. The server node providing a service-access-point for accessing users (reads on either the persons own computer, their modem that is accessing the internet OR the Internet Service Provider server used by the customer to access the internet);

Applicant's response

Applicant points out that APA describes a personal computer, as follows, “Anyone with a suitable Internet appliance such as a personal computer with a standard Internet connection may access (go on-line) and navigate to information pages (termed web pages) stored on Internet-connected servers for the purpose of garnering information and initiating transactions with hosts of such servers 15 and pages” (Page 2, lines 10-15).

Applicant argues that there is no teaching in APA providing a personal computer providing a service-access point for a user, as claimed. The personal computer taught in APA is a tool to connect to the service-access point provided in a first server. Further, applicant points out that APA does not even mention the word “modem” or “Internet Service Provider”. Therefore, the Examiner is either adding subject matter to APA or inserting his own personal knowledge as prior art, although “Official Notice” has not been made by the Examiner. Applicant herein challenges the Examiner's implied “Official Notice” and requests the Examiner provide valid art showing a modem, personal computer or ISP providing an access-point on a wide area network for a user of a bill-payment service. Therefore, applicant has clearly shown Applicant's arguments are persuasive as applicant has shown that APA does not teach what the examiner has stated it teaches.

Applicant has amended independent claim 13, after the initial rejection in the Office Action mailed 5/07/2007, therefore, the balance of the Examiner's remarks in

section 10 of said Office Action will not be addressed as said rejections are now moot in view of said claim amendment.

Examiner's rejection

"If applicant is of the opinion that the APA does not set forth aggregation of all of an individual's bill paying requirements, then resort may be had to the teachings of Kolling to show that it is known in the bill pay art to provide a system that is capable of interfacing with all of a person's billing needs. See for example, the abstract, figures and col. 1, lines 14- 37, col. 2 lines 63 through col. 4 line 18, col. 11 line5 through col. 13, lines 15, etc.

At the time of the invention it would have been obvious to one of ordinary skill in the art to apply the teachings of Kolling to APA in order to aggregate all of a person's billing requirements into one location for the purpose and benefit of convenience, to both the person and the billers in standardizing the method in which bills are paid for the additional benefit of saving the billers money by minimizing failures of payment"

Applicant's response

Applicant's claims to not include a limitation reciting, "provide a system that is capable of interfacing with all of a person's billing needs.", which the Examiner assumes Kolling teaches. There are numerous detailed limitations in applicant's claims that are *not* taught by the Examiner's assumption of the teaching of Kolling. Applicant's claim 13 has been amended, extensively, since the Examiner first asserted this rejection in the Office Action dated 05/07/2007. Applicant respectfully requests the Examiner reject amended claim 13 using the art of Kolling and APA, showing applicant's specific limitations, as claimed, in the art of APA or Kolling; then applicant will gladly respond to the rejection in detail.

Examiner's rejection

4. Applicant's arguments regarding section 5 of the previous Office action have been fully considered but they are not persuasive.

Per Applicant's admission:

"...claims may be differently worded and still define the same invention. Thus, a claim reciting a widget having a length of "36 inches" defines the same invention as a claim reciting the same widget having a length of "3 feet."

This appears to be the case here. It appears Applicant fails to appreciate the similarities/correlation of the following limitations. Note that the claims have been updated by the current amendment and reflected herein, that is, the analogies here are based on the new claims received 10/31/2007.

Applicant's response

Applicant herein provides a Terminal disclaimer to overcome the double patenting rejection.

Merit rejections under 35 U.S.C. 103

6. Claims 13-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over APA in view of Kolling for the reasons set forth in section 3 above, which in directs attention to section 4 of the previous Office action mailed 10/12/2007, which in turn directs attention to section 10 of the previous Office action mailed 5/7/2007.

It is not seen wherein applicant has overcome the arguments already of record.

Applicant's response

Applicant points out that the claims were amended in the last response, which are not acknowledged by the Examiner in the rejection dated 05/07/07, or the rejection dated 10/12/2007. When the Examiner chooses to assert this rejection, in the proper manner, addressing all of the limitations of claim 13 and dependent claims, as amended, by showing them in prior art, applicant will respond to the rejection. The Examiner has the initial burden to show applicant's claimed subject matter in the art.

Examiner's rejection

7. Claims 13-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over DCU Bill Payer in view of Horvitz "Panel: Innovations in Money and Payment Preserving Competition in Electronic Home Banking"

Regarding claim 13, DCU sets forth an interactive bill-payment system, comprising:

A first server node connected to a wide area network, the first server node providing a service-access-point for accessing users (See, for example, page 1, the first sentence of the first paragraph and 4th paragraph, first sentence, "Bill Payer Screen in Dial-Up PC Branch");

A bill-payment software executing on the first server node, providing an interactive interface where the user may pay selected itemized bills,

Applicant's response

DCU does not appear to expressly disclose a second server node connected to the network and accessible to the first server node, the second server node providing automated navigation to billing sources subscribed to by the user collecting itemized bills and bill related data and providing same to the first server node.

Horvitz an article concerning innovations in electronic commerce and electronic home banking. Horvitz discloses that AS OF November 1996, (almost 12 years ago) it was known that:

"Electronic home banking, as generally conceived, does not involve cutting-edge technology or sophisticated services. Most planning involves only bill paying and ability access account information on-line. This usually includes the ability to transfer funds between accounts, and perhaps to open CDs. Other functions are further down the road, such as the ability to replenish a stored-value card, or the ability to receive bills electronically.

It should be noted that while access to account information obviously requires some connection with the bank, bill paying is not on-line with the bank and, in fact, does not even need the participation or cooperation of the bank. Electronic home banking involves several pieces and the combined efforts of several participants.

Some electronic device is needed in the home, but there has been uncertainty as to whether the most promising device is the telephone, interactive TV, or the personal computer (Bogolin 1995). The first two have the advantage of universal presence and familiarity. Telephone banking is already well established and utilized for limited functions. The PC

is a device better suited for banking functions (the presence of a keyboard and printer are important), but now only about **34** percent of households have PCs, and only about half of these have modems.

Home banking also requires some user interface or software system. Intuit's Quicken is by far the leading product on the market, with Microsoft's Money and Meca's Managing Your Money far behind. Only Quicken has an economically significant base of existing users, though independent reviews of these three products find them comparable in quality.

There must also be a communication system. This must involve an interface or switching with the bank for access to account information, and communication with back-end bill-paying operation. Ultimately, that bill paying will be electronic, but at present as much as 50-70 percent of the payments made by third-party bill payers are paper based. Many payees cannot accept electronic payment, and many others avoid such payments since the costs (at existing low volumes) are substantially higher than the costs of handling checks.

At the present time, no single bank or firm has the products and expertise to provide all the pieces of a comprehensive home banking service." (Emphasis added)

At the time of the invention it would have been obvious to one of ordinary skill to utilize the teachings of Horvitz to modify DCU in order to arrive at a comprehensive home banking service including a second server node connected to the network and accessible to the first server node, the second server node providing automated navigation to billing sources subscribed to by the user collecting itemized bills and bill related data and providing same to the first server node as such is nothing more than aggregating all financial accounts and dealings into a comprehensive home banking service. Again, **Horvitz teaches motivation to arrive at such an invention** and disclose several companies pursuing the same interests.

Applicant's response

Applicant is not clear on what limitations Horvitz teaches as it is not stated by the Examiner. The Examiner states what DCU does not teach, then presents a full page of Horvitz text without pointing out in Horvitz where it is taught, "a second server node connected to the network and accessible to the first server node, the second server node

providing automated navigation to billing sources subscribed to by the user collecting itemized bills and bill related data and providing same to the first server node.”

Applicant points out that there are three basic criteria for meeting a prima facie case of obviousness:

1. There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings.
2. There must be a reasonable expectation of success.
3. The prior art reference (or references when combined) must teach or suggest all the claim limitations.

Applicant believes the Examiner’s present rejection fails to meet all three challenges.

Horvitz teaches, “Home banking also requires some user interface or software system.” applicant believes this teaching cannot extend past applicant’s claimed first server node.

Horvitz teaches “There must also be a communication system. This must involve an interface or switching with the bank for access to account information, and communication with back-end bill-paying operation.” Applicant believes that the communication system may read on the Wide Area Network (WAN). Applicant understands the reference of Horvitz teaches that payments may be made to billers via communication with back-end bill-paying operation.

What the reference of Horvitz fails to teach is applicant’s claimed limitations of, “a second server node connected to the network and accessible to the first server node, the second server node providing automated navigation to billing sources subscribed to by the user, collecting itemized bills and bill-related data, and providing same to the first server node; and bill-payment software executing on the first server node, providing an interactive interface where the user may view and pay selected itemized bills.”

Applicant argues that Horvitz is concerned with relieving automated bill-paying of sending paper checks on behalf of users. Horvitz fails to teach or suggest providing automated navigation to billing sources subscribed to by the user, collecting itemized bills and bill-related data, and providing same to the first server node. Horvitz and DCU may teach software, but neither of them teach software installed on a first server node enabling a

user to view and pay itemized bills. The art of DCU expressly teaches that the user receives a bill (paper), selects a vendor and enters the bill amount to pay (page 1, 2nd paragraph). Horvitz provides a limited teaching of a Home Banking Service with absolutely no suggestion or enabling teaching touching on applicant's claimed second server connected to the network and accessible to the first server node, the second server node providing automated navigation to billing sources subscribed to by the user, collecting itemized bills and bill-related data, and providing same to the first server node. Horvitz even goes as far to admit that, "At the present time, no single bank or firm has the products and expertise to provide all the pieces of a comprehensive home banking service."

Applicant argues that the Examiner may not assume that the comprehensive home banking service alluded to by Horvitz, as someday existing in the future, includes the unique second server, as claimed in applicant's invention. That is improper examining procedure and fails to meet the 3 requirements of a 103 rejection stated above. Applicant's claim 13 is clearly patentable over DCU and Horvitz, either singly or in combination.

Examiner's rejection

Claims 13-23 are rejected under 35 U.S.C. 103(a) as being obvious over U.S. Patent 5,903,881 to Schrader et al. (Schrader) in view of MPEP section 2144.04 as cited immediately below.

V. MAKING PORTABLE, INTEGRAL, SEPARABLE, ADJUSTABLE, OR CONTINUOUS

C. Making Separable

In re Dulberg, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) (The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is "press fitted" and therefore not manually removable. The court held that "if it were considered desirable for any reason to obtain access to the end of [the prior art's] holder to which the cap is applied, it would be obvious to make the cap removable for that purpose.").

VI. REVERSAL, DUPLICATION, OR REARRANGEMENT OF PARTS

C. Rearrangement of Parts

In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950) (Claims to a hydraulic power press which read on the prior art except with regard to the position of the starting switch were held unpatentable because shifting the position of the starting switch would not have modified the operation of the device.); *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975) (the particular placement of a contact in a conductivity measuring device was held to be an obvious matter of design choice). However, "The mere fact that a worker in the art could rearrange the parts of the reference device to meet the terms of the claims on appeal is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for the worker in the art, without the benefit of appellant's specification, to make the necessary changes in the reference device." *Ex parte Chicago Rawhide Mfg. Co.*, 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

Per claim 13 Schrader sets forth an interactive bill-payment system comprising:

- a first server node connected to a wide-area network. the first server node providing a service-access-point for a user (See for example, the Abstract, Col. 5 line 58-Col. 6 line 67, Col. 13, lines 45-50, etc.)
- a bill-payment software executing on the first server node, providing an interactive interface where the user may view and pay selected itemized bills (See for example the Abstract, The Figures, Col. 13, lines 7+, etc.)

Applicant's Response

Applicant points out that Schrader fails to teach bill pay software enabling the user to access an interactive interface where the user may view and pay selected itemized bills. All of the figures in Schrader show vendor payment windows, not itemized bills to be paid, as claimed. The Abstract of Schrader is reproduced below:

“A software product, computer implemented method, and system provide an integrated user interface having three simultaneously displayed items of information, including a list of transaction instructions, a list of uncleared transactions, and a list of cleared transactions. The simultaneous display, and interaction between the lists, provides for integration of various tasks separately associated with personal finance software products and with online banking products. Two account balances are also simultaneously displayed, a balance for cleared transactions, and a separate balance based on both cleared and uncleared transactions. The two balances provide the user with a complete view of the status of their account and available funds. The software product and system supports online bill payment, electronic funds transfer, and checkbook transactions, without requiring navigation through multiple, separate user interfaces for different modules of the product.”

Applicant cannot find a teaching or suggestion in the above Abstract teaching applicant's claimed software displaying itemized bills. Applicant has read column 13 of Schrader and has failed to find a teaching of bill pay software on any server providing an interactive interface where the user may view and pay selected itemized bills. Applicant respectfully requests the Examiner please point out exactly where said software is taught in Schrader.

Examiner continues...

In contrast to the claimed invention, Schrader discloses that it is the software operating on the first node that is providing the automated navigation to the billing sources subscribed to by the user collecting itemized bills and bill related data, and presenting same to the software executing on the first server node.

Accordingly, Schrader does not appear to expressly disclose that it is a "second server" node connected to the network and accessible to the first server node providing the automated navigation to the billing sources subscribed to by the user collecting itemized bills and bill-related data, and presenting same to the software executing on the first server node.

Considering the teachings of MPEP 2144.04.V.C. Making separable, especially In re Dulberg, 129 USPQ 348, (CCPA 1961)

"It has been held that constructing a formerly integral structure in various elements involves only routine skill in the art"

At the time of the invention it would have been obvious to one of ordinary skill in the art to utilize not only a "second server" but any number of servers to provide automated navigation to the various financial accounts as such is nothing more than a separation of parts. Schrader discloses that the aggregation of the data is done by a first server. There is no novelty in merely separating the aggregation module from the first node and placing in on a second node when the end result remains the same. That is, the first node still has the information to process and display to the user. Again, it makes no difference how one of ordinary skill in the art could chop up the different modules of Schrader to function on any number of server nodes as long as the end result remains the same, i.e. a one stop shop for all the financial information a user desires to view.

Also, one must consider the teachings of MPEP 2144.04.VI.C. regarding the rearrangement of parts of Schrader. At the time of the invention it would have been obvious to one of ordinary skill in the art to rearrange which module gathers the financial data from the various accounts online. That is, it would have been obvious to place the account aggregation module on a second server that is located at a remote location with constant online connection for the benefits of having a server node online at all times that can access and update multiple accounts without the user having to be online to get said updates. Schrader teaches that the program must go online to retrieve current data for each account. Downloading information from multiple various sources can be time consuming. Accordingly for the benefit of saving time, it would have also been obvious to place the aggregation module on a second server. Schrader discloses that the aggregation of the data is done by a first server but again there is no novelty in merely rearranging where the aggregation module resides, merely that it exists and is performing its intended function, i.e. retrieve account information for any account the user desires. Again the end result remains the same, that is, the first node still has the information from all of the accounts.

If applicant is of the opinion that Schrader is only concerned with bank accounts and not applicable to the viewing and manipulation other financial accounts, then resort must be had to the "teachings" of Schrader teaches in Col. 5 lines 11-35

"As the foregoing discussion indicates, users of these various types of online banking products have to navigate between multiple different user interfaces to perform a single task. Usability research on users working with these types of products has shown that at each navigation step, there was high potential for error and confusion. Users are not always sure how information in one user interface screen is related to information in another screen, or when it is necessary to switch to another part of the product to proceed through a task.

The need for easy-to-use and efficient online banking software products and systems becomes even more pronounced when considering that different users have different needs, expectations, and abilities. Research has shown that there are two types of users of financial software products: Organizers and Transactors. Organizers specifically intend to use their financial software products to organize, categorize, and track their finances with precision and detailed accuracy. For these types of users, conventional software products that provide the ability to categorize transactions, produce complex reports of income and expenses, and the like are seen as useful tools." (Emphasis added)

Specifically "Organizers specifically intend to use their financial software products to organize, categorize, and track their finances with precision and detailed accuracy."

Finances can be defined as "The management of money, banking, investments, and credit."

Clearly Schrader can not only be considered as be directed towards online banking, but to the total management of ALL of a users finances. Accordingly, Schrader's invention is considered as applicable to access any and all financial accounts of a user. See for example, at least, Col. 8 lines 10-25.

Applicant's response

Applicant argues that the Examiner's statement that, "Schrader discloses that it is the software operating on the first node that is providing the automated navigation to the billing sources subscribed to by the user collecting itemized bills and bill related data, and presenting same to the software executing on the first server node." is pure conjecture and assumption. There is no such teaching in Schrader. Schrader specifically teaches that, "The application interface module 1403 enables the personal online finance application 304 to

execute as a plug-in in various online environments such in America Online™, Netscape Communications Inc.'s Navigator™, and Microsoft Corp.'s Internet Explorer™. This module is implemented on a per environment basis. When invoked, this module initializes the rest of the personal online finance application 304 and on completion ensures its safe termination. The application interface module 1403 is a hidden window that transfers data from the user interface and the rest of the modules using a messaging architecture. This module transfers state information from the operating environment to the user interface module 1401, and to the other modules. This enables the application 304 to be used with a variety of different operating environments. (emphasis added) (col. 13, lines 45-60)

Applicant points out that this software teaching of Schrader is a messaging software specifically for state information for an operating environment, which the Examiner may not construe to mean “providing automated navigation to billing sources subscribed to by the user, collecting itemized bills and bill-related data, and providing same to the first server node.”

Just as argued above, regarding DCU and Horvitz, Schrader also has been clearly shown to be absent of any teaching or suggestion of software navigating to billing sources subscribed to by the user for the purpose of obtaining itemized bills and serving them to an interactive bill paying window at a first server. Applicant does not need to address the MPEP reference as Schrader fails to provide teaching of applicant's claimed invention on one server or component.

The Examiner states; “Schrader's invention is considered as applicable to access any and all financial accounts of a user. See for example, at least, Col. 8 lines 10-25. Applicant presents the cited portion below:

“Display of Transaction Instructions

The out box 167 contains zero or more transaction instructions 169 that are to be sent to a financial institution for processing. A transaction instruction 169 is a description of an action to be performed by a financial institution or other financial entity or a request for information from a financial institution. A financial institution may be the user's bank, a

clearinghouse, or other institution which processes electronic transactions, transfers, or otherwise is involved in the handling of transaction instructions or user's accounts, payments, or fund transfers. Financial entities may include vendors, merchants, billing agencies, banks, brokerages, insurance companies, or the like. Generally, the out box 167 is used to show bill payments to various merchants and fund transfers between user selected accounts."

Applicant points out that the entire teaching above relates to showing bill payment information and instruction, not actual itemized bills, as claimed.

As claim 13 is patentable to the applicant over the art cited and applied by the Examiner, claims 14-23, all depended directly or indirectly from claim 13 are patentable at least as depended from a patentable claim, and rejections in the action specifically directed to one or more depended claims are moot.

Summary

As all of the claims standing for examination have been shown to be patentable as amended and argued above over the art of record, applicant respectfully requests reconsideration, and that the present case be passed quickly to issue. If there are any time extensions needed beyond any extension specifically requested with this response, such extension of time is hereby requested. If there are any fees due beyond any fees paid with this amendment, authorization is given to deduct such fees from deposit account 50-0534.

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